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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,986	10/20/2005	Masanao Suga	Q90792	1007
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WASHINGTON, DC 20037-3213				
EXAMINER				
TRAN, MY CHAUT				
ART UNIT		PAPER NUMBER		
2629				
NOTIFICATION DATE		DELIVERY MODE		
01/04/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SUGHRUE265550@SUGHRUE.COM

USPTO@SUGHRUE.COM

PPROCESSING@SUGHRUE.COM

Office Action Summary

Application No.

10/553,986

Applicant(s)

SUGA, MASANAO

Examiner

MY-CHAU T. TRAN

Art Unit

2629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2009 has been entered.

Application and Claims Status

2. Applicant's amendment(s) and response filed 09/29/2009 are acknowledged and entered.

3. Claims 1-6 were pending. Applicants have amended claims 5 and 6; cancelled claims 1-4; and added claims 7 and 8. Therefore, claims 5-8 are currently pending and are under consideration in this Office Action.

Status of Claim(s) Objection(s) and/or Rejection(s)

4. All previous claims objection(s) and/or rejection(s) have been withdrawn in view applicant's amendments of claims 5 and 6 and/or cancellation of claims 1-4 thereto.

Priority

5. This instant application is a 371 of PCT/JP04/05820 filed on 04/22/2004, and as a result this instant application has the effective filing date of 04/22/2004.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The term “*controls to subdivide*” of claims 5 and 6 is vague and indefinite because it is unclear as to whether the action being performed by the claimed device, i.e. ‘*display processing unit*’, is a physical action (transforming an article or material) or abstract ideas (an algorithm and/or data structures of a software code). Thus, claims 5 and 6 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

b. The term “*displayed can be grasped*” of claims 5 and 6 is vague and indefinite because it is unclear to whether the action being performed by the claimed device, i.e. ‘*display processing unit*’, is a physical action (transforming an article or material) or abstract ideas (a thought process, an algorithm, and/or data structures of a software code). Consequently, claims 5 and 6 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

c. The term ‘*member*’ of claims 5 and 6 is vague and indefinite because it is unclear as to the meets and bound of the term ‘*member*’. That is it is unclear whether the term ‘*member*’ is a structural feature such as a register, transistor, or a jump-condition circuit; or a functional/process limitation of the claimed device, i.e. ‘*display processing unit*’. Moreover, it is also unclear whether the term ‘*member*’ refers to the claimed “*a storage*

member”, i.e. is the term ‘*member*’ synonymous with the term “*a storage member*”, or a distinct structural feature. Additionally, the original specification only provided a broad generic description for this term. That is the term ‘*member*’ would encompass the definition of a memory storage device such as a ROM or EPROM (i.e. a storage member) or an algorithm and/or data structures of a software code (see specification pgs. 7-8; fig. 2). As a result, claims 5 and 6 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

d. The phrase “*when the left key is dressed*” of claim 6 vague and indefinite because it is unclear as to the meets and bound of the phrase ‘*when the left key is dressed*’. That is how does a left key dressed? Or how does ‘*changing the uppermost order digit to 0*’ would dress a left key? Therefore, claim 6 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (US Patent 4,794,553).

For *claim 5*, first, *claim 5* recites a numeral value display system. The system comprises the structural feature of a) a numeral value display device, b) a processing unit, c) a storage

member, and d) an operation key that includes an up key, a down key, a left key, and a right key wherein these keys are interpreted as arrow keys. This interpretation regarding the claimed keys is fully supported by the original specification (see fig. 8, ref. #3, 4, 10, and 11).

Here, Watanabe et al. disclose an electronic calculator (see e.g. Abstract; col. 1, lines 59-68; col. 2, lines 47-55). As illustrated by figure 1, the calculator (refers to instant claimed numeral value display system) comprises a control section (ref. #2) (refers to instant claimed display processing unit) with a ROM (ref. #2A) (refers to instant claimed storage member), key input section (ref. #1) (refers to instant claimed operation key), and a display section (ref. #8) (refers to instant claimed numeral value display device) (see e.g. col. 4, lines 6-58). Although Watanabe et al. do not expressly disclose that the operational keys include arrow keys; it is art recognized that graphical calculator would also include arrow functional keys as evidence by Phipps et al. (US Patent 5,532,946; fig. 1).

Additionally, the claimed functional limitations for the instant claimed a) display processing unit (i.e. *'in a case that a display processing unit executes such an operation that the numeral value stored in a storage member is read out to display the read numeral value, if a digit number of the numeral value to be displayed is larger than a displayable digit number of the numeral value display device, the display processing unit that control to subdivide the numeral value into a preset digit number in order that such a fact that which numeral portion of the numeral value to be displayed is displayed can be grasped, and to display a portion of the subdivided numeral values'* and *'a member for incrementing an editing digit when the up key is depressed; a member for decrementing the editing digit when the down key is depressed; a member for incrementing an editing digit variable when the left key is depressed; a member for*

decrementing the editing digit variable when the right key is depressed; a member for determining a value of a display unit variable based upon the value of the editing digit variable; and a member for switching a portion of a numeral value to be displayed based upon the value of the display unit variable to display the switched portion of the numeral value and for clearly displaying the relevant editing digit"); b) operation key (i.e. 'for switching the display of the numeral value display device in a manual manner and for editing the numeral value, wherein while an editing digit variable is set to the display processing unit, the editing digit variable representing an editing digit position is required so as to edit a portion of a numeral value, which is displayed on the numeral value display device every dividing digit number'); and the arrow keys (i.e. 'an up key for depressing to increment an editing digit; a down key for depressing to decrement an editing digit; a left key for depressing to increment the editing digit variable; and a right key for depressing to decrement the editing digit variable, in the numeral editing') do not impart any structural distinction between the devices of Watanabe et al. (i.e. the display processing unit, operation key, and the arrow keys) and the instant claimed devices (i.e. the display processing unit, operation key, and the arrow keys); and as a result the device of Watanabe et al. would still anticipate the instant claimed device since the device of Watanabe et al. meet all the structural limitations of the instant claimed device, i.e. a display processing unit, a storage member, an operation key, and a numeral value display device of instant claim 5. See MPEP § 2114, which states as follows:

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART
>While features of an apparatus may be recited either structurally or functionally, claims< directed to
>an< apparatus must be distinguished from the prior art in terms of structure rather than function.
>In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device

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does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

And also that:

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Moreover, Watanabe et al. also disclose that the control section (ref. #2) (refers to instant claimed display processing unit) can ‘*executes such an operation that the numeral value stored in the storage member is read out to display the read numeral value*’ as claimed in instant claim 5 (see e.g. col. 4, lines 19-40).

For *claim 6*, first, claim 6 recites a numeral value display system. The system comprises the structural feature of a) a numeral value display device, b) a processing unit, c) a storage member, and d) an operation key that includes an up key, a down key, and a left key, wherein these keys are interpreted as arrow keys. This interpretation regarding the claimed keys is fully supported by the original specification (see fig. 8, ref. #3, 4, 10, and 11).

Here, Watanabe et al. disclose an electronic calculator (see e.g. Abstract; col. 1, lines 59-68; col. 2, lines 47-55). As illustrated by figure 1, the calculator (refers to instant claimed numeral value display system) comprises a control section (ref. #2) (refers to instant claimed display processing unit) with a ROM (ref. #2A) (refers to instant claimed storage member), key input section (ref. #1) (refers to instant claimed operation key), and a display section (ref. #8) (refers to instant claimed numeral value display device) (see e.g. col. 4, lines 6-58). Although Watanabe et al. do not expressly disclose that the operational keys include arrow keys; it is art

recognized that graphical calculator would also include arrow functional keys as evidence by Phipps et al. (US Patent 5,532,946; fig. 1).

Additionally, the claimed functional limitations for the instant claimed a) display processing unit (i.e. *'in a case that a display processing unit executes such an operation that the numeral value stored in a storage member is read out to display the read numeral value, if a digit number of the numeral value to be displayed is larger than a displayable digit number of the numeral value display device, the display processing unit that control to subdivide the numeral value into a preset digit number in order that such a fact that which numeral portion of the numeral value to be displayed is displayed can be grasped, and to display a portion of the subdivided numeral values'* and *'a member for incrementing an editing digit when the up key is depressed; a member for decrementing the editing digit when the down key is depressed; a member for incrementing an editing digit variable until the digit is reached to an uppermost order digit and for changing the uppermost order digit to 0 when the left key is dressed; a member for determining a value of a display unit variable based upon the value of the editing digit variable; and a member for switching a portion of a numeral value to be displayed based upon the value of the display unit variable to display the switched portion of the numeral value and for clearly displaying the relevant editing digit'*); b) operation key (i.e. *'for switching the display of the numeral value display device in a manual manner and for editing the numeral value, wherein while an editing digit variable is set to the display processing unit, the editing digit variable representing an editing digit position is required so as to edit a portion of a numeral value, which is displayed on the numeral value display device every dividing digit number'*); and the arrow keys (i.e. *'an up key for depressing to increment an editing digit; a*

down key for depressing to decrement an editing digit; and a left key for depressing to increment the editing digit variable, in the numeral editing' do not impart any structural distinction between the devices of Watanabe et al. (i.e. the display processing unit, operation key, and the arrow keys) and the instant claimed devices (i.e. the display processing unit, operation key, and the arrow keys); and as a result the device of Watanabe et al. would still anticipate the instant claimed device since the device of Watanabe et al. meet all the structural limitations of the instant claimed device, i.e. a display processing unit, a storage member, an operation key, and a numeral value display device of instant claim 6. See MPEP § 2114, which states as follows:

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A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Moreover, Watanabe et al. also disclose that the control section (ref. #2) (refers to instant claimed display processing unit) can *'executes such an operation that the numeral value stored in the storage member is read out to display the read numeral value'* as claimed in instant claim 6 (see e.g. col. 4, lines 19-40).

For *claim 7*, first, *claim 7 recites a control apparatus. The control apparatus comprises a numeral value display system of claim 5. The system of claim 5 comprises the structural*

feature of a) a numeral value display device, b) a processing unit, c) a storage member, and d) an operation key that includes an up key, a down key, a left key, and a right key wherein these keys are interpreted as arrow keys. This interpretation regarding the claimed keys is fully supported by the original specification (see fig. 8, ref. #3, 4, 10, and 11).

Here, Watanabe et al. disclose an electronic calculator (see e.g. Abstract; col. 1, lines 59-68; col. 2, lines 47-55). As illustrated by figure 1, the calculator (refers to instant claimed control apparatus/numeral value display system) comprises a control section (ref. #2) (refers to instant claimed display processing unit) with a ROM (ref. #2A) (refers to instant claimed storage member), key input section (ref. #1) (refers to instant claimed operation key), and a display section (ref. #8) (refers to instant claimed numeral value display device) (see e.g. col. 4, lines 6-58). Although Watanabe et al. do not expressly disclose that the operational keys include arrow keys; it is art recognized that graphical calculator would also include arrow functional keys as evidence by Phipps et al. (US Patent 5,532,946; fig. 1).

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member for incrementing an editing digit variable when the left key is depressed; a member for decrementing the editing digit variable when the right key is depressed; a member for determining a value of a display unit variable based upon the value of the editing digit variable; and a member for switching a portion of a numeral value to be displayed based upon the value of the display unit variable to display the switched portion of the numeral value and for clearly displaying the relevant editing digit'); b) operation key (i.e. 'for switching the display of the numeral value display device in a manual manner and for editing the numeral value, wherein while an editing digit variable is set to the display processing unit, the editing digit variable representing an editing digit position is required so as to edit a portion of a numeral value, which is displayed on the numeral value display device every dividing digit number*'); and the arrow keys (i.e. 'an up key for depressing to increment an editing digit; a down key for depressing to decrement an editing digit; a left key for depressing to increment the editing digit variable; and a right key for depressing to decrement the editing digit variable, in the numeral editing*') do not impart any structural distinction between the devices of Watanabe et al. (i.e. the display processing unit, operation key, and the arrow keys) and the instant claimed devices (i.e. the display processing unit, operation key, and the arrow keys); and as a result the device of Watanabe et al. would still anticipate the instant claimed device since the device of Watanabe et al. meet all the structural limitations of the instant claimed device, i.e. a display processing unit, a storage member, an operation key, and a numeral value display device of instant claim 5. See MPEP § 2114, which states as follows:*

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Moreover, Watanabe et al. also disclose that the control section (ref. #2) (refers to instant claimed display processing unit) can ‘executes such an operation that the numeral value stored in the storage member is read out to display the read numeral value’ as claimed in instant claim 5 (see e.g. col. 4, lines 19-40).

For **claim 8**, first, claim 8 recites a control apparatus. The control apparatus comprises a numeral value display system of claim 6. The system of claim 6 comprises the structural feature of a) a numeral value display device, b) a processing unit, c) a storage member, and d) an operation key that includes an up key, a down key, a left key, and a right key wherein these keys are interpreted as arrow keys. This interpretation regarding the claimed keys is fully supported by the original specification (see fig. 8, ref. #3, 4, 10, and 11).

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Moreover, Watanabe et al. also disclose that the control section (ref. #2) (refers to instant claimed display processing unit) can 'executes such an operation that the numeral value stored in the storage member is read out to display the read numeral value' as claimed in instant claim 6 (see e.g. col. 4, lines 19-40).

Therefore, the device of Watanabe et al. does anticipate the instant claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/MY-CHAU T. TRAN/
Primary Examiner, Art Unit 2629

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